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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,308	09/05/2003	Gerard Labauze	A35523-PCT-USA-A - 070337	8191

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EXAMINER	
COSTALES, SHRUTI S	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,308	LABAUZE, GERARD	
	Examiner	Art Unit	
	Shruti S. Costales	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/5/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on September 5, 2003 was filed in compliance with the provisions of 37 CFR § 1.97. Accordingly, the information disclosure statement filed by the applicant has been considered by the Examiner.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because the English language translation of the declaration filed on December 22, 2003 contains numerous typographical errors as a result of the translation. It is therefore not clear what it is that the applicant is swearing to in the declaration.

Specification

3. The abstract of the disclosure is objected to because the applicant makes improper use of legal phraseology, such as "comprising". See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A rubber composition for a tire tread and a tire having diene elastomers and a hydrocarbon plasticizing resin".

Claim Objections

5. Claim 1 is objected to because it is not clear from the language of claim 1 whether the glass transition of the diene elastomers or the hydrocarbon plasticizing

resin is 10° to 150° C. It is to be noted that according to the specification, see for example, page 8, paragraph [027], the glass transition of the hydrocarbon plasticizing resin is disclosed to be 10° to 150° C. Appropriate correction or clarification of claim 1 is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0477682 A1 to The Goodyear Tire & Rubber Company (cited on the PTO-1449 submitted by the applicant on September 5, 2003) in view of EP 0899297 A2 to The Goodyear Tire & Rubber Company (cited on the PTO-1449 submitted by the applicant on September 5, 2003).

'682 discloses a pneumatic rubber tire having a rubber tread of a specified rubber composition (Page 2, line 3), wherein the composition includes (a) about 40 to about 60 phr styrene/butadiene copolymer rubber, (b) about 20 to about 30 parts by weight cis 1,4-polyisoprene rubber, and (c) 20 to 30 parts by weight cis-1,4-polubutadiene rubber (Page 2, lines 20-27). The polybutadiene/styrene copolymer rubber has a glass transition temperature in the range of about –25° C to about –50° C, the cis-1,4-polyisoprene rubber has a glass transition temperature of –65° to about –85° C and the cis 1,4-polybutadiene rubber has a glass transition temperature of about –75° to about – 105° C (Page 2, lines 29-31). The rubber composition also includes 1-5 phr of a synthetic hydrocarbon as a tackifier (Page 3, lines 1-3). The combination of components (a) and (b) in '682's composition corresponds to the majority diene elastomer of the presently cited claims. The composition may further include processing aids such as paraffinic oil and aromatic processing oils in a range of about 2 to about 10 phr (Page 2, lines 54-58). Conventional compounding ingredients such as carbon black and silica (Page 2, lines 43-46) are also disclosed, wherein the silica corresponds to the reinforcing white filler.

The difference between '682 and the presently claimed invention is the requirement that the hydrocarbon resin is present in an amount of 15 to 25 phr, has a glass transition temperature of 10° to 150° C, and has a molecular weight of 400 g/mol and 2000 g/mol, the cis-1,4-polybutadiene contains a cis-1,4 linkage of 90% or more, and a tire of a passenger-vehicle or heavy-vehicle type may be prepared from the composition.

'297, which is drawn to a pneumatic tire having a tread made of a composition including rubbers such as styrene/butadiene copolymers, solution polymerized polybutadiene rubber, emulsion polymerized polybutadiene rubber, and polybutadiene rubber having 95% or more cis-1,4-structure (Page 2, paragraphs [0001]-[0005]), discloses a hydrocarbon resin in an amount of 15 to 50 phr, wherein the hydrocarbon resin includes coumarone-indene resins, petroleum resins, terpene resins, terpene polymers and mixtures thereof (Page 2, paragraph [0003] and Page 3, paragraphs [0010]-[0012]). The coumarone-indene resins have melting points ranging from 10° to 160° C and have molecular weights ranging from 420 to 700 g/mol (Page 3, paragraph [0012]). It is also disclosed that petroleum resins have softening points of from 10° to 120° C (Page 3, paragraph [0014]). '297 also discloses that the tires resulting from the composition disclosed in '297 are useful for passenger tires, aircraft tires, truck tires, and the like (Page 5, paragraph [0033]). It would have been obvious to one of ordinary skill in the art to use the specific hydrocarbon resin and rubber of '297 in the rubber composition of '682 because the resulting tire would be useful for passenger vehicles (Page 5, paragraph [0033]) and exhibits improved treadwear, traction, and handling (Page 2, paragraph [0001]), thereby obtaining the invention as set forth in the presently cited claims.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-14, and 16-17 of copending Application No. 10/655,782 published as U.S. Pre-Grant Publication Number 2004/0122157. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Both the claims of the '782 copending application and the present application recite a composition which includes diene elastomer(s) and a hydrocarbon plasticizing resin. The amounts and T_g related properties of the above-named ingredients strongly overlap. While the hydrocarbon plasticizing resin of '782 is excluded from being based on cyclopentadiene or dicyclopentadiene, nevertheless even with this exclusion, the diene elastomers that do fall within the scope of '782 overlap the ones broadly recited in the present claims. Reinforcing fillers such as carbon black and a reinforcing white filler are also recited in '782 and cis-1,4 linkages of greater than 90% in the synthetic polyisoprene and polybutadiene are also recited. '782 also recites a tread and a tire resulting from the recited composition.

With respect to the plasticizing oil recited in claim 1 of '782, the oil is optional as it is present in an amount of 0 to 26 phr, therein maintaining an overlap with claim 1 of the present application. In those embodiments where the plasticizing oil is not optional, claim 1 of '782 overlaps with claim 13 of the present application. Therefore it would have been obvious to one of ordinary skill in the art to obtain the cited claims of the present application from the cited claims of '782.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-17 are directed to an invention not patentably distinct from claims 1-2, 6-14, and 16-17 of the commonly assigned copending application, namely 10/655,782. Specifically, refer to the discussion above in paragraph 9.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned copending Application No. 10/655,782, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Although EP 1035164 A1 has been cited on the International Search Report for PCT/EP02/02559, of which the present application is a continuation of, as an "X" reference, said EP reference has not been used to formulate a prior art rejection because such a rejection would be cumulative to the rejection already set forth in paragraph 7 above.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shruti S. Costales whose telephone number is (571) 272-8389. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

SSC
Shruti S. Costales
August 15, 2005

Vasu Jagannathan
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